PTO/SB/21 (09-04)
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Total Number of Pages in This Submission	7

Application Number	09/554,132
Filing Date	05/09/2000
First Named Inventor	Gunnar WAHLSTEN
Art Unit	2634
Examiner Name	D. Ha
Attorney Docket Number	1314

ENCLOSURES *(Check all that apply)*

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- ☐ Amendment/Reply
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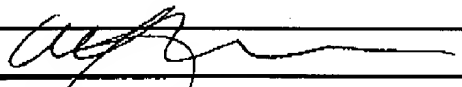
Signature			
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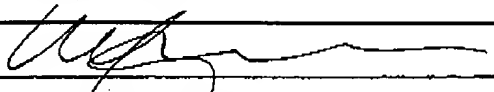
Signature			
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1314

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of	]	
	]	
Gunnar WAHLSTEN	]	
	]	Group Art Unit 2634
Serial No.: 09/554,132	]	
	]	
Filing Date: May 9, 2000	]	Examiner: D. Ha
	]	
For: METHOD AND ARRANGEMENT FOR WIRELESS DATA TRANSMISSION	]	

REPLY BRIEF

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in reply to the Examiner's Answer dated December 14, 2006, which responded to the arguments raised in the Appeal Brief filed on September 25, 2006.

The underlying question in this appeal is the propriety of the combination by the examiner of three references that were cited and relied upon in connection with the rejection as obvious of six of the claims pending in this application, including the two independent claims, and the combination by the examiner of five references in connection with the rejection as obvious of four dependent claims.

The examiner's arguments as set forth in the Examiner's Answer show that the references as assembled and as combined by the examiner can only be based upon the examiner's hindsight reasoning while having the present invention in mind.

By that hindsight reasoning, the examiner has picked and chosen particular elements of particular ones of the references to assemble a mosaic that allegedly supports the obviousness of the present invention as claimed. From the vast number of prior art references available, a select few were chosen based upon the present application, and parts of them were then identified and selected to form the basis for the obviousness rejections.

The statute that provides the basis for an obviousness rejection is 35 U.S.C. § 103 (a), which provides in pertinent part: "A patent may not be obtained...if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which such subject matter pertains." Thus, the obviousness evaluation is to be based upon the "person having ordinary skill in the art." And the skill level of such an ordinarily skilled person was characterized by the Court of Appeals for the Federal Circuit as follows:

> The issue of obviousness is determined entirely with reference to a hypothetical "person having ordinary skill in the art." It is only that hypothetical person who is presumed to be aware of all the pertinent prior art. The actual inventor's skill is irrelevant to the inquiry, and this is for a very important reason. The statutory emphasis is on a person of ordinary skill. Inventors, as a class, according to the concepts underlying the Constitution and the statutes that have created the patent system, possess something -- call it what you will -- which sets them apart from the workers of ordinary skill, and one should not go about determining obviousness under § 103 by inquiring into what patentees (i.e., inventors) would have known or would likely have done, faced with the revelations of references. *A person of ordinary skill in the art is also presumed to be one who thinks along the line of conventional wisdom in the art and is not one who undertakes to innovate, whether by patient, and often expensive, systematic research or by extraordinary insights, it makes no difference which.* See the last sentence of § 103, supra.

Standard Oil Co. v. American Cyanimid Co., 227 U.S.P.Q. 293, 297-98 (Fed. Cir. 1985) (emphasis added).

Because the person of only ordinary skill is not one who innovates, and because such a person is deemed to think only along the line of conventional wisdom, there must be some objective motivation that would cause such a person to do something that would differ from the conventional wisdom in the art. And the conventional wisdom would be that which the art specifically teaches. Consequently, there must be in the record some evidentiary basis that would motivate one of only ordinary skill in the art to do something that is a departure from and that goes beyond the conventional wisdom. No such evidence is present in the record of this application.

Indeed, what the examiner has shown is that individual elements of the claimed invention are known. But he has not shown just how the ordinarily skilled person would start from the Nelson et al. reference and would modify it to attempt to arrive at the claimed invention, based upon some suggestion or motivation in the references. It must be recalled that the hypothetical ordinarily skilled person is presumed to be aware of all the prior art, and the examiner has not shown where the motivation arises to select from the vast body of prior art the specific references relied upon and then to excise from those individual references particular individual elements to arrive at his obviousness conclusion. The only possible explanation is that the present disclosure was used by the examiner as a template or as a road map, first, to select the references, and, second, to select particular parts of those references alleged to be combinable, while ignoring other parts of the references.

The examiner's combination of references is based only upon hindsight while

having the present invention in mind. In that regard, he has not pointed to teachings in the references that lead the non-innovator, one who follows the conventional wisdom, to the claimed invention. Instead, he has reasoned backwards from the selected references. That backwards reasoning is evidenced by the examiner's use of the following phrases in connection with his discussion of how he arrived at the obviousness rejections (emphasis added in each instance):

"a person of ordinary skill in the art *would have* looked to," (Examiner's Answer, page 4, line 5),

"a clock *could* originate," (Examiner's Answer, page 4, line 13),

"what one *would* have wanted to, (Examiner's Answer, page 4, line 21),

"*would* be capable," (Examiner's Answer, page 5, line 7),

"one *would* have looked," (Examiner's Answer, page 5, lines 11-12),

"*if* Nelson contemplated," (Examiner's Answer, page 5, line 18),

"*would* have realized," (Examiner's Answer, page 7, line 5),

"*would* have easily realized," (Examiner's Answer, page 7, line 9),

"*would* have looked," (Examiner's Answer, page 8, line 3), and

"*would* have been," (Examiner's Answer, page 8, line 16).

Significantly, those phrases are all conditional phrases that show that the obviousness conclusion is based upon the examiner's assumptions and upon backwards reasoning from the references while having the present invention in mind – it is not based upon any positive statements or suggestions in the references that would evidence a motivation provided in the references to a non-innovator who only follows the conventional wisdom in the art.

The examiner does not refer to any statements or suggestions to combine. And that lack of any such reference is because the references contain no such suggestion or motivation for one to combine them as the examiner has done. In that regard, it is not enough that disclosures *could* hypothetically be combined in some particular way. The mere possibility of a particular combination of elements does not make that combination obvious. And that particular individual elements of a claimed invention are known or can be found scattered in various prior art references is by itself insufficient to establish a *prima facie* case of obviousness. The obviousness rejection in this case is based solely upon the premise that because individual elements or functions exist, it would be obvious to combine them in some way to justify an obviousness rejection.

The record is devoid of any evidence of a suggestion, teaching, or motivation to combine the references as the examiner has done. There are only the examiner's conclusory statements, which are insufficient to establish a *prima facie* case of obviousness. See, e.g., *In re Dembiczak*, 175 F.3d 994, 50 U.S.P.Q.2d 1614, 1618 (Fed. Cir. 1999) ("...the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention."). The obviousness rejections in this case are similarly based only on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention."

CONCLUSION

For the foregoing reasons, and also for all the reasons and arguments that are

set forth in the Appeal Brief filed on September 25, 2006, the obviousness rejections in the present application should be reversed.

Respectfully submitted,

February 14, 2007

Alfred J. Mangels
Reg. No. 22,605
4729 Cornell Road
Cincinnati, Ohio 45241
Telephone: (513) 469-0470